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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Peter Habermeyer

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ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-3873

EXAMINER

STEWART, JASON-DENNIS NEILKEN

ART UNIT

PAPER NUMBER

3738

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,459	<b>Applicant(s)</b> HABERMEYER ET AL.	
	<b>Examiner</b> JASON-DENNIS STEWART	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8, and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The following is a Non-Final Office action in response to communications received on 11/14/08. Claims 2, 3, 9, 10 and 12-16 have been cancelled. Claims 1, 6-8, and 11 have been amended. Therefore, Claims 1, 4-8, and 11 are pending and addressed below.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2008 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornier 2003/0149485 in view of Guederian et al. 2004/0059424 in view of Nicol et al. 7,097,663

4. Regarding Claim 1 Tornier illustrates at least a two-piece humeral prosthesis with a joint head **1** and three part design attachment **2, 3, 4** with a disk-like portion having a medial hole **25** (fig. 1) making the attachment hollow. Tornier further illustrates a circular collar **23** around the medial hole. The phrase “to effect an at least cement-free anchoring attachment” is seen as an intended use limitation being that all structure is present in the prior art invention. Tornier, discloses a shank with grooves for attachment, however, Tornier does not disclose a screw for attachment.

Guederian illustrates a hollow screw **8**, and at least a two part design for an attachment part (Fig. 4) of a prosthesis including a circular collar **200** with projections on a first side (Fig. 1).

It would have been obvious to one of ordinary skill of the art to modify the device of Tornier with hollow screw of the Guederian because screws are a means for attachment commonly known to a skilled artisan in manufacturing and in order to provide bone growth into the screw as taught by Guederian (paragraph 19).

Tornier in view of Guederian discloses the invention as claimed and as discussed above. However, Tornier in view of Guederian does not disclose a positioning body with a second side having a relatively smaller diameter and at least nearly circular projecting collar projecting outwardly from the second side.

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Nicol discloses a positioning body **126** that has a second side with a relatively smaller diameter and at least nearly circular projecting collar that is inserted into to humeral head **102** (Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Tornier in view of Guederian in order to effectively lock and secure the collar to the joint head component.

5. Regarding Claim 4, Tornier illustrates a joint head with a nearly spherical surface and an opening with an angle alpha less than 180 degrees (Fig. 1).

6. Regarding Claim 5, Tornier illustrates a circular support surface 23 with a conical support edge that rests on support edge (fig. 5).

7. Regarding Claim 6, Tornier illustrates a hollow receiver 11 on the side opposite the nearly spherical surface (fig. 1).

8. Regarding Claim 7, Tornier illustrates a slightly conical receiver wall 12 and a slightly conical external collar surface 24 (fig. 3).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being anticipated by Guederian et al. 2004/0059424 in view of Nicol et al. 7,097,663 further in view of Keynan 2003/0050704.

Guederian discloses a method of fitting a shoulder prosthesis comprising fitting the attachment part on previously prepared bone with the use of projections 209 and 214, after which anchoring body is affixed to the bone by hollow screw 8 through a

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medial hole 206 in the positioning body (paragraphs 15 – 20). Guederian also discloses a collar 203 which serves to abut component 100. It should be noted that phrase "Method of fitting ..., ...attachment body within the bone" is in the preamble of the method claim and do not provide any specific method steps and thus is given limited patentable weight. However, Guederian does not disclose a positioning body with a second side having a relatively smaller diameter and at least nearly circular projecting collar projecting outwardly from the second side.

Nicol discloses a positioning body **126** that has a second side with a relatively smaller diameter and at least nearly circular projecting collar that is inserted into to humeral head **102** (Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Guederian in order to effectively lock and secure the collar to the joint head component.

Guederian in view of Nicol discloses the invention as claimed and as discussed above. However, Guederian in view of Nicol does not positively claim the step of implanting an attachment body of a humerus without cement.

Keynan discloses implanting a humeral attachment piece to a prepared humerus without the use of bone cement (paragraph 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Guederian in view of Nicol by implanting a piece into a humerus without bone cement in order to prevent any possible inflammatory responses or other adverse reactions using

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guederian et al. 2004/0059424 in view of Nicol et al. 7,097,663 in view of Keynan 2003/0050704 further in view of Tornier 2003/0149485.

11. Guederian in view of Nicol in view of Keynan discloses the invention as claimed and as discussed above. However, Guederian does not disclose a hollow receiver with a slightly conically shaped wall, a collar with a slightly conically shaped edge, and an external force used to fix the attachment body.

Tornier illustrates a slightly conical receiver wall 12 and a slightly conical external collar surface 24 (fig. 3) for the purpose of mating the joint head and the anchoring means as well as a force (E1) used to fix the parts of the prosthesis together.

It would have been obvious one of ordinary skill in the art at the time of the invention to modify the method of Guederian with the steps of Tornier in order to securely fix the femoral head to the anchoring means during surgery.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON-DENNIS STEWART whose telephone number

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is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason-Dennis Stewart/  
Examiner, Art Unit 3738

/Brian E Pellegrino/  
Primary Examiner, Art Unit 3738